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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,001

12/16/2005

Valerie Andre

12810-00180-US

6009

23416

7590

03/03/2008

CONNOLLY BOVE LODGE & HUTZ, LLP

P O BOX 2207

WILMINGTON, DE 19899

EXAMINER

DODSON, SHELLEY A

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

03/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,001	Applicant(s) ANDRE ET AL.	
	Examiner SHELLEY A. DODSON	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/16/2005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-4 are pending in this application filed December 16, 2005.

Applicant's claims are directed toward mixtures of UV-A and UV-B filters.

Claim Rejections - 35 USC § 101

1.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.

Claim 4 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant is advised that the term "use" does not describe a process step and that the law does not permit the claiming of an invention in terms of use. Applicant is further advised that the claim should read "method of using or method of use".

Claim Rejections - 35 USC § 112

3.

Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 of the above stated claim is viewed as indefinite because applicant has a period after the word formula II instead of after the actual formula. In order for the claim to be definite the period should be placed at the end of the actual structure and not at the end of the sentence. Clarification is necessary.

Claim 4 is viewed as indefinite because of the term “use” in the claim. The term “Use” or “using” does not describe a process step. Ex parte Dunki, 153 USPQ 678. The law does not permit the claiming of an invention in terms of use. Clinical Products. v Brenner, Commr, Patents, 149 USPQ 475.

Claim Rejections - 35 USC § 103

4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

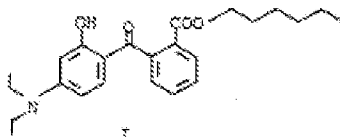
Art Unit: 1616

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.

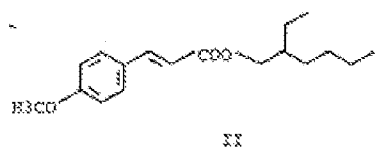
Claims 1-4 rejected under 35 U.S.C. 103(a) as being unpatentable over Heidenfelder et al. USP No. 6,458,342, cited and supplied by applicant in view of Martin et al. 2002/0137795 A1.

Heidenfelder et al. disclose use of sunscreen combinations comprising an effective amount of compound A absorbing in the UV-A region and an effective amount of compound B absorbing in the UV-A region, in the UV-B region and in both regions. Heidenfelder further discloses that the composition comprises an effective amount of one or more compounds chosen from the group consisting of compound B. In column 12, compound XIII corresponds to formula I as claimed by applicant in the instant application.



Art Unit: 1616

In column 8, formula II corresponds to formula II claimed by applicant in the instant application.



Heidenfelder discloses that an effective amount of compound A and B are present in the referenced sunscreen composition. It is the examiner's position that it would have been obvious to delete compound A and the property that it imparts from the instant invention because both formula I and formula II from compound B provide both UV-A and UV-B sunscreen protection without the use of compound A.

Heidenfelder discloses all aspects of the instant invention with the exception of specifically stating that the compounds of formula I and formula II absorb in the UV-A and UV-B range. It is for that reason that Martin et al. is joined.

Martin et al disclose compounds capable of screening out both UV-A and UV-B radiation. On page 2 [0027] Martin discloses that 2-ethylhexyl p-methoxycinnamate is capable of screening out UV-B radiation. This corresponds to applicant's formula II and to the UV-B filter claimed by applicant. Additionally, on pages 2 and 3 Martin further discloses amino-substituted benzophenone derivative capable of screening out UV-A radiation. This corresponds to applicant's formula I and to the UV-A filter claimed by applicant.

Telephone Inquiries

6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHELLEY A. DODSON whose telephone number is (571) 272-0612. The examiner can normally be reached from 7:30 AM to 4:00 PM Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached at 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SHELLEY A. DODSON/
Primary Examiner, Art Unit 1616